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EXAMINER

HENEGHAN, MATTHEW E

ART UNIT

PAPER NUMBER

2134

DATE MAILED: 12/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/544,236

Applicant(s)

RUBIN, AVIEL D.

Examiner

Matthew Heneghan

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 April 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. Claims 1-22 have been examined.

***Information Disclosure Statement***

2. The following Information Disclosure Statement in the instant application has been fully considered:

Paper #3, filed 17 May 2000.

3. U.S. Patent No. 5,303,296 to Zucker, the only reference in Paper #2, the Information Disclosure Statement filed 7 April 2000, was missing from the instant application. A replacement copy of U.S. Patent No. 5,303,296 has been printed and added to the file wrapper, and has been fully considered.

***Drawings***

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: figure 5, item "504." A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(I) because the lines are not uniformly thick and well-defined. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

6. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract is greater than 150 words in length.

### ***Claim Objections***

7. Claim 6 is objected to because of the following informality: It is dependent upon itself. Appropriate correction is required. For purposes of the prior art search, it is being presumed that the claim is dependent upon claim 2.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-3, 6, 9-14, 21, and 22 are rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 5,629,982 to Micali.

As per claims 1 and 2, Micali discloses an electronic transaction system in which electronic signatures are attached to return receipts are sent to "Alice," the calling party (see column 12, lines 23-34), which also certifies the identity of the recipient, "Bob." Micali further states that the mail system uses computer networks, which inherently transmit message as a set of digitized packets (see column 4, lines 58-65).

As per claim 3, return certificates are being generated by the certification provider (the "Post Office").

As per claim 6, all such messages are being signed using an encryption key,  $E_A$  (see column 5, lines 10-20).

As per claim 9, Micali discloses that a signature may simply consist of a public key (see column 5, lines 30-35).

As per claim 10, Micali discloses that these are mail messages (see column 4, lines 49-52).

As per claims 11, 12, 14, the initial message sent by Alice to the Post Office is signed and includes a certificate (see column 11, line 62 to column 1, line 3).

As per claim 13, the Post Office acts as a judging system as well as a certifying system.

As per claims 21 and 22, Micali discloses that sessions may be initiated from telephones, faxes, etc., which would be off-network (see column 4, lines 59-62).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4, 5, 7, 8, and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,629,982 to Micali.

Regarding claims 4 and 5, the system disclosed by Micali does not incorporate a judging authority, but Micali discloses the use of a judging authority in a prior art system

by Ben-Or et al., and further suggests that judging authorities reduce the probability that one party receives a contract, certifying the transaction, while the other does not.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Micali by adding a judging authority, in order to reduce the probability that one party receives a contract, certifying the transaction, while the other does not.

Regarding claim 7, Micali discloses that the sender ("Alice") must indicate that she is using an ICM (return receipt) transaction (see column 11, line 66 to column 12, line 3), but does not state that she is prompted for that information.

Official notice is given that it well-known in the art that computer programs may prompt users when determining whether or not to employ an optional feature.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to implement the invention of Micali by prompting Alice when determining whether or not to employ ICM, which is an optional feature.

As per claim 8, the return receipt received by Alice has been encrypted using Alice's key, and includes Bob's publicly verifiable signature (see column 4, line 66 to column 5, line 20 and column 12, lines 17-34), and is therefore verifiable by Alice.

Regarding claims 15 and 16, Micali discloses that Alice is a user, but does not discuss the network configuration being used by Alice.

Official notice is given that it is well-known in the art that in network communications, a user using a corporate network would be using a customer premises equipment system.

Official notice is also given that in corporate networks, it is well-known in the art that proxy servers are used to isolate the internal network from unwanted network traffic.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further implement the invention of Micali by having Alice use a corporate network, which would be a customer premises equipment system, and to implant on the corporate network a proxy server, in order to isolate the internal network from unwanted network traffic.

Regarding claims 17 and 18, Micali does not specify the type of system on which the Post Office or judging authorities are implemented.

Official notice is given that network utilities that is well-known in the art that network utilities that are simultaneously available to a large number of users are implemented on servers, in order to allow for efficient, consistent service to all authorized users.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further implement the invention of Micali by using a server for the Post Office or judging authority, in order to allow for efficient, consistent service to all authorized users.

10. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,629,982 to Micali as applied to claim 11 above, and further in view of U.S. Patent No. 5,633,916 to Goldhagen et al.



Micali discloses the use of his invention for telephone, fax, broadcast, or other communications networks (see column 4, lines 58-65), but does not explicitly specify that messages may be voice or multimedia mail.

Goldhagen discloses a system a universal messaging system, wherein both multimedia and voice messages may be sent (see column 6, lines 4-32), and suggests that the "Universal Mailbox Service" enables Windows/PC-based applications to perform all the functions currently available to telephone-based NAP Voice and Facsimile subscribers.

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to implement the invention of Micali as a "Universal Mailbox Service," as disclosed by Goldhagen, in order to enable Windows/PC-based applications to perform all the functions currently available to telephone-based NAP Voice and Facsimile subscribers.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,535,276 to Ganesan discloses a system for securing transmissions using certification and judging servers.

U.S. Patent No. 6,137,884 to Micali further expounds upon U.S. Patent No. 5,629,982 to Micali, which has been cited in this office action.

U.S. Patent No. 6,188,766 to Kocher discloses a system for authenticating and timestamping fax transmissions.

U.S. Patent No. 6,263,051 to Saylor et al. discloses a centralized voice transmission system.

U.S. Patent No. 6,327,656 to Zabetian discloses a system for certifying and judging transmitted electronic documents.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (703) 305-7727. The examiner can normally be reached on Monday-Thursday from 8:00 AM - 4:00 PM Eastern Time. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse, can be reached on (703) 308-4789.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, DC 20231

**Or faxed to:**

(703) 872-9306

Hand-delivered responses should be brought to Crystal Park 2, 2121 Crystal Drive, Arlington, VA 22202, Fourth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

  
GREGORY MORSE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

• Application/Control Number: 09/544,236  
Art Unit: 2134

Page 10

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December 22, 2003